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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,963	09/20/2001	Hiroshi Sumiyama	018775-842	1910

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EXAMINER
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AYELE, MARIO

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/955,963	<b>Applicant(s)</b> SUMIYAMA ET AL.	
	<b>Examiner</b> Mario Ayele	<b>Art Unit</b> 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show "element 16" as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing.

MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

The disclosure is objected to because of the following informalities: On page 7, lines 16-17 of the specification the applicant state "a buffer memory for storing the image data created with the reading device", later stating "The buffer memory 30 is not provided having the function of storing image data", on page 12 lines 3-4. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

**Claims 2-5, 9-16, 18, 20** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language regarding **claims 2-5, 10, 13, and 15**, where these claims disclose retrieval means for retrieving a memory-incorporating apparatus, are not understood. Retrieval means cannot retrieve a memory-incorporating apparatus. The language in these claims must be made clear and understandable. For the following rejections it is assumed that claims are directed to retrieving the image memory of the memory-incorporating apparatus, where image data is transferred.

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Regarding **claims 9-16, 18, and 20, where 9, 18, and 20** are independent claims, the preamble stating "an image forming apparatus incorporating no image memory" contradicts the remaining part of the claim that states "a printing device for forming a copy the image document on a sheet of paper based on the image data stored in the buffer memory". The specification fails to disclose "buffer memory" in relation to "an image forming apparatus incorporating no image memory".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-6, 8-14, and 16-20** are rejected under 35 U.S.C. 102(b) as being anticipated by Nisihyama (U.S. Patent Number 6,894,792).

Regarding **claims 1 and 17**, Nisihyama discloses an image forming apparatus incorporating no image memory (digital coping machine 91, column 12, lines 48-54), an input device for receiving image data as an input (column 2, lines 35-39), a transfer means for transferring the image data received by the input device to an image memory of a memory-incorporating apparatus connected to an input device via the network (column 2, lines 40-46), a key for generating a signal in response to operation by a user

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(Figure 9b, 'correction data retrieval' button), reception means for receiving the image data stored in the image memory in accordance with the signal (Figure 11, element 91a-93a), a printing device for forming a image with use of the image data received by the reception means (Figure 11, element 91-93).

Regarding **claims 2 and 10**, Nisihiyama discloses a retrieval means for retrieving the memory-incorporating apparatus connected to the network (column 21, lines 4-7).

Regarding **claims 3 and 11**, Nisihiyama discloses a transfer means to transfer image data to the memory-incorporating apparatus retrieved by the retrieval means (from column 2, line 66 -- column 3 line3).

Regarding **claims 4 and 12**, Nisihiyama discloses a warning device informing a user that the retrieval means cannot identify any memory-incorporating apparatus (column 18, lines 47-49).

Regarding **claims 5 and 13**, the rational provided in the rejections of claim 2 are incorporated herein. In addition, Nisihiyama discloses a transfer instruction means for inputting a data transfer instruction in response to operation by a user (from column 2 line 63 – column 3 line 4).

Regarding **claims 6 and 14**, Nisihiyama discloses the key is displayed on a display device (column 4, lines 46-48).

Regarding **claims 8 and 16**, Nisihiyama discloses the key is displayed on the display device during or after image forming operation by the printing device with use of image data inputted by the input device (Figure 17a-17c, element 121a; column 4, lines 43-51).

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Regarding **claim 9**, the rational provided in the rejections of **claim 1** are incorporated herein. In addition, Nisihiyama discloses a buffer memory for storing the image data created by the reading device, and a printing device for forming a copy of the image document on a sheet of paper based on the image data stored in the buffer (column 12, lines 52-54).

Regarding **claim 18**, the rational provided in the rejections of **claims 9** is incorporated herein.

Regarding **claim 19**, the rational provided in the rejections of **claims 1** is incorporated herein.

Regarding **claim 20**, the rational provided in the rejections of **claims 9** is incorporated herein.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 7 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nisihiyama et al (U.S. Patent Number 6,894,792).

Regarding **claims 7 and 15**, which state, "the key is displayed when the retrieval means identifies a memory-incorporating apparatus, whereas the key is not displayed

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when the retrieval means identifies no memory-incorporating apparatus". In the Nisihiyama reference the liquid crystal display is always displayed. Nisihiyama also discloses a flowchart when the external memory (memory-incorporating apparatus) is unable to store image data request (figure 27, element S118). However, Nisihiyama fails to teach, "the key is not displayed when the retrieval means identifies no memory-incorporating apparatus". Official notice is taken that it was well known in the art at the time of invention to remove a key or menu after the option is no longer available. It would have been obvious to remove the key if the retrieval means identifies no memory-incorporating apparatus because to still have key displayed creates confusion and a user can waste time viewing an option that no longer has use.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mario Ayele whose telephone number is 571-272-0624. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.




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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mario Ayele  
Examiner  
Art Unit 2622

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